UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
RUTLEDGE, AMELIA L

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/814,554	HAILEY ET AL.
	Examiner	Art Unit	
	Amelia Rutledge	2176	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 June 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>25-30,34-46 and 52</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>25-30, 34-46, and 52</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Amendment, filed 06/22/2007.

2.   Claims 25-30, 34-46, and 52 are pending in the case. Claims 25, 34, and 52 are

independent claims.

3.   Claims 35 and 36 have been amended to overcome the claim rejections under

35 U.S.C. 112, second paragraph, therefore those claim rejections have been

withdrawn.

Claim Objections

1.   Claims 31-33 and 47-51 are objected to because of the following informalities:

claims 31-33 and 47-51 are withdrawn, therefore they should be removed from the

listing of pending claims. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 25-30, 34-46, and 52 are rejected under 35 U.S.C. 101 because the

claimed invention is directed to non-statutory subject matter.

Claims 25-30, 34-46, and 52 describe a computer readable medium having a

schema for a document generation system (claims 25-30), and a computer readable

medium having a data structure for a document (claims 34-46), and describe the

various elements included in the schema and data structure. As such, claims 25-30 and

34-46 and 52 are directed to nonfunctional descriptive material, and claim mere arrangements or compilations of facts or data, without any functional interrelationship. At best the claims are directed to software *per se*. For example, claim 34 claims a data structure for a document, and a collection of elements, but does not claim a functional interrelationship among that data and the computing processes performed when utilizing that data. The claimed invention should demonstrate how the data structure is used and how it causes functional change in the computer.

The following passage from the *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility* (hereinafter "*Interim Guidelines*"), p. 55, emphasis added, further explains nonfunctional descriptive material.

Nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. § 101. Certain types of descriptive material, such as music, literature, art, photographs and **mere arrangements or compilations of facts or data, without any functional interrelationship** is not a process, machine, manufacture or composition of matter. USPTO personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. § 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon

recognizing that particular sequence, causes another defined series of notes to be

played, defines a functional interrelationship among that data and the computing

processes performed when utilizing that data, and as such is statutory because it

implements a statutory process.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   **Claims 25-30, 34-46, and 52 are rejected under 35 U.S.C. 102(e) as being**

anticipated by Mohr et al. (hereinafter "Mohr"), U.S. Patent No. 6,826,727 B1,

issued November 2004.

Regarding independent claim 25, Mohr teaches a computer readable medium

having instructions for generating instances of a document based on a template

structured according to a schema, since Mohr teaches a system for laying out

documents with flexible layout process and variable data publishing system (col. 2, l.

40-col. 6, l. 38; Abstract). Mohr teaches that the schema comprises a template root

element (col. 11, l. 10, l. 43-col. 11, l. 26; col. 13, l. 39-67); a template information

element (col. 13, l. 22-67). Mohr teaches a data table element configured to contain

data that is used to transform an abstract instance of a document template to a concrete instance of a document template (col. 11, l. 60-col. 24; col. 12, l. 65-col. 13, l. 38; Figs. 49, 50), since Mohr teaches content mapping rules to map variable data from different template files, and a given template file can be used with content mapping rule sets of different projects (col. 38, l. 47-col. 39, l. 60). Mohr also teaches mapping content from a data table element of content mapping rules (col. 39, l. 15-51; col. 40, l. 5-col. 41, l. 30). Mohr teaches that the schema comprises an instances element containing at least one instance element (col. 38, l. 47-col. 39, l. 60), which describes how each individual instance of the document is constructed (col. 14, l. 29-45; col. 11, l. 10, l. 43-col. 11, l. 26; col. 13, l. 39-67), since Mohr teaches dynamically mapping files into a template container that is a variable element (col. 13, l. 39-67; col. 42, l. 37-col. 43, l. 37).

Regarding dependent claim 26, Mohr teaches that the instance element is configurable to include an instance data table element (col. 38, l. 47-col. 39, l. 60), a pages element (col. 11, l. 43-59), an overlays element, i.e., layout box element (col. 11, l. 26-42), a continuations element, i.e., element for designating size and positioning (col. 42, l. 37-col. 43, l. 37; col. 11, l. 20-59; col. 14, l. 29-45), and a data element (col. 13, l. 6-38).

Regarding dependent claim 27, Mohr teaches that the pages element is configurable to include a page element and the page element is configurable to include an overlays element and a composition element (col. 14, l. 59-col. 15, l. 12), since Mohr teaches that certain template elements can be mapped to variable elements, and Mohr teaches mapping variable text elements (col. 11, l. 42-col. 12, l.

24), the nesting of elements to include other elements, and mapping of content into box

elements and shape elements (col. 13, l. 6-21; col. 14, l. 29-45).

Regarding dependent claim 28, Mohr teaches that the overlays element is

configurable to include one or more overlay elements, which is implied by the disclosure

of nested elements (col. 11, l. 2-26) and the mapping of variable values (col. 12, l. 16-

col. 13, l. 38).

Regarding dependent claim 29, Mohr teaches that the continuations element is

configurable to include one or more continuation elements and one or more overflow

default elements, which is implied by the disclosure of nested elements (col. 11, l. 2-26)

and the mapping of variable values (col. 12, l. 16-col. 13, l. 38; col. 25, l. 8-24).

Regarding dependent claim 30, Mohr teaches that the instance data table

element is configurable to include one or more datum elements, which is implied by the

disclosure of nested elements (col. 11, l. 2-26) and the mapping of variable values (col.

12, l. 16-col. 13, l. 38).

Regarding independent claim 34, Mohr teaches a computer readable medium

having instructions for generating instances of a document based on a template defining

a data structure for the document, since Mohr teaches a system for laying out

documents with flexible layout process and variable data publishing system (col. 2, l.

40-col. 6, l. 38; Abstract).   Mohr teaches that the template schema comprises a

template root element (col. 11, l. 10, l. 43-col. 11, l. 26; col. 13, l. 39-67); a template

information element (col. 13, l. 22-67); a data table element (col. 11, l. 60-col. 24; col.

12, l. 65-col. 13, l. 38), since Mohr teaches content mapping rules to map variable data

from a database table (col. 13, l. 2-6), i.e., a data table element.

Mohr teaches that the template schema comprises an instances element

including at least one instance element configured to describe how a document is

constructed (col. 14, l. 29-45; col. 11, l. 10, l. 43-col. 11, l. 26; col. 13, l. 39-67), since

Mohr teaches dynamically mapping files into a template container that is a variable

element (col. 13, l. 39-67; col. 11, l. 60-col. 24; col. 12, l. 65-col. 13, l. 38; Figs. 49, 50).

Mohr teaches content mapping rules to map variable data from different template files,

and a given template file can be used with content mapping rule sets of different

projects (col. 38, l. 47-col. 39, l. 60).

Mohr teaches that the instance element includes an instance data table element

and at least one continuations element, the continuations element defining continuation

handling for data included in the data table element, the instance data table element, or

both, because Mohr teaches different content mapping rules for different projects and

elements within the projects, in order to create variable page elements for each project

(col. 38, l. 47-col. 40, l. 53; col. 42, l. 37-col. 43, l. 37).

Regarding dependent claim 35, Mohr teaches that the template information

element includes descriptive information about the template element (col. 13, l. 22-67).

Regarding dependent claim 36, Mohr teaches that the descriptive information

includes a title element that contains a title for the document at hand (Fig. 50, items

130C, 130D, and 130E), a description element that is a container for free-form text

about the template element (col. 13, l. 6-38), a help text element, which is a container

for free-form information that may be useful to a consumer of the document (col. 13, l.

6-38), and Mohr implies a document type element that is provided to support a type

element from other schemas or DTDs (col. 12, l. 65-col. 13, l. 38), since Mohr teaches

using content mapping rules, the association of outside files, and mapping element

content to a digital asset management system.

Regarding dependent claim 37, Mohr teaches that the template information

element includes a print constraints element which is a container for special values

that may be needed or used by a printing environment (col. 41, l. 3-55).

Regarding dependent claim 38, Mohr teaches that the data table element

includes data values to be used in a specific instance of a template, (col. 14, l. 29-45;

col. 11, l. 10, l. 43-col. 11, l. 26; col. 13, l. 39-67), since Mohr teaches dynamically

mapping files into a template container that is a variable element (col. 13, l. 39-67).

Regarding dependent claim 39, Mohr teaches that the data table element

defines a structure of data values that can be accessed by name, or by a combination of

name and one or more indices (col. 12, l. 17-col. 13, l. 37).

Regarding dependent claim 40, Mohr teaches that the instances element is

configured to include one or more instance elements, which is implied by the disclosure

of nested elements (col. 11, l. 2-26) and the mapping of variable values (col. 12, l. 16-

col. 13, l. 38).

Regarding dependent claims 41-45, claims 41-45 are directed to substantially

similar subject matter as claimed in claims 26-29, and are rejected along the same

rationale.

Regarding dependent claim 46, Mohr teaches that continuation elements are configured to be used by a processor to process overflows (col. 42, l. 36-col. 43, l. 63).

Regarding independent claim 52, Mohr teaches a computer readable medium having instructions for generating instances of a document based on a template structured according to a schema, since Mohr teaches a system for laying out documents with flexible layout process and variable data publishing system (col. 2, l. 40-col. 6, l. 38; Abstract).

Mohr teaches that the schema comprises a data table element configured to contain data that is used to transform an abstract instance of a document template to a concrete instance of a document template (col. 11, l. 60-col. 24; col. 12, l. 65-col. 13, l. 38; Figs. 49, 50), since Mohr teaches content mapping rules to map variable data from different template files, and a given template file can be used with content mapping rule sets of different projects (col. 38, l. 47-col. 39, l. 60).

Mohr teaches that the template has an instances element containing at least one instance element, because Mohr teaches different content mapping rules for different projects and elements within the projects, in order to create variable page elements for each project (col. 38, l. 47-col. 40, l. 53).

Response to Arguments

2.   Applicant's arguments filed 06/22/2007 have been fully considered but they are not persuasive.

In response to applicant's arguments regarding the claim rejections of claims 25-30 and 34-46 under 35 U.S.C. 101 as being directed to non-statutory subject matter (Remarks, p. 7), applicant's amendments to the claims are not sufficient to overcome the rejections under 35 U.S.C. 101 because the amended claims also do not cause functional change in the computer, and at best are directed to software *per se*. A *computer readable medium having instructions for...* does not cause a functional change in the computer, but instead represents a data structure or listing of instructions.

In response to applicant's arguments regarding the rejections of claim 1 as anticipated by Mohr (Remarks, p. 7-9), Mohr does teach that the schema comprises a data table element configured to contain data that is used to transform an abstract instance of a document template to a concrete instance of a document template (col. 11, l. 60-col. 24; col. 12, l. 65-col. 13, l. 38; Figs. 49, 50), since Mohr teaches content mapping rules to map variable data from different template files, and a given template file can be used with content mapping rule sets of different projects (col. 38, l. 47-col. 39, l. 60).

Regarding the arguments for dependent claim 26 (Remarks, p. 9-10), in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the specific interpretation of "continuations element") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, Mohr does teach a continuations element at

col. 42, l. 37-col. 43, l. 37 since Mohr teaches handling text layout under different

arrangements.

For these reasons, and the reasons of record, the claim rejections should be

maintained.

Conclusion

3.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Amelia Rutledge whose telephone number is 571-272-

7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

Customer Service Representative or access to the automated information system, call

800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR

WILLIAM BASHORE
PRIMARY EXAMINER